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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/091,555

03/07/2002

Toshio Furuta

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05/23/2005

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EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,555

Applicant(s)

FURUTA, TOSHIO

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/04:03/07/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 have been examined. Application 10/091,55 (ELECTRONIC COUPON METHOD, ELECTRONIC COUPON SYSTEM, MARKETING SERVER, PURCHASER TERMINAL, ORDER-RECEIVING TERMINAL, AND PROGRAM) has a filing date 03/07/2002 and foreign data 03/12/2001.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-10 are rejected under 35 U.S.C. 101 because based on the theory that the claim is directed to neither a "method" nor a "system," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A single claim which claims both a system and a method is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17. USPQ2d 1548 (Bd. Pat. App. & Inter. 1990)

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-17 and 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen (US 6,002,771).

As per claim 1, Nielsen teaches:

An electronic coupon method employed in a network system having a purchaser terminal, a marketing server (see "Vendor Computer system"; figure 1), and a network via which said purchaser terminal (see "user computer system"; see figure 1) and said marketing server are mutually connected (see figure 1), whereby said marketing server manages product information for a marketed product (see column 2, lines 17-25) and an electronic coupon including encrypted discount information regarding said product (see column 2, lines 17-25; column 5, line 50 – column 6, line 29; figure 5), establishing a relationship of correspondence there between and, when there is a request to obtain said electronic coupon for a certain product from a purchaser terminal, sends said requested electronic coupon to said purchaser terminal which originated said request (see column 2, lines 17-35), and

wherein said purchaser terminal displays said electronic coupon sent from said marketing server and, said user decrypts said discount information encrypted in said

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electronic coupon by following use's decryption instructions, and displays said information on a display unit (see column 5, line 50 – column 6, line 29).

As per claims 2, 11 and 21-24, Nielsen teaches:

An electronic coupon method employed in a network system having a purchaser terminal (see “user computer system”; see figure 1), a marketing server (see “vendor computer system”; see figure 1), and a network via which said purchaser terminal and said marketing server are mutually connected (see figure 1), whereby said marketing server manages product information for a marketed product and electronic coupons including encrypted discount information regarding said product (see column 2, lines 17-25; column 5, line 50 – column 6, line 29; figure 5), establishing a relationship of correspondence there between, said purchaser terminal displays on its own display unit product information managed by said marketing server and obtained via said network, and sends to said marketing server a request to obtain an electronic coupon corresponding to a product selected by an user viewing said display unit (see column 2, lines 17-35), said marketing server sends said requested electronic coupon to said purchaser terminal which originated said request (see column 2, lines 17-35), in accordance with said request to obtain said electronic coupon sent from said purchaser terminal, said purchaser terminal displays an electronic coupon sent from said marketing server on said display unit, decrypts discount information encrypted within said electronic coupon in accordance with user decryption instructions and display it on said display unit (see column 5, line 50 – column 6, line 29), and sends order information to said marketing server to the effect that said user will purchase said

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selected product, in accordance with user ordering instructions, with using said electronic coupon (see column 6, lines 47-60), and

said marketing server calculates a discount price based on discount information in said electronic coupon indicated for use by said order information sent from said purchaser terminal, and processes payment using said discount price (see column 7, lines 1-25).

As per claims 3, 12 and 13, Nielsen teaches:

An electronic coupon system according to claim 2, wherein said system is further provided with an order receiving terminal connected to said marketing server via said network (see figure 1), whereby said purchaser terminal sends product information regarding a marketed product and an electronic coupon including encrypted discount information to said marketing server (see figure 7), and

said marketing server manages said product information for said product sent from said purchaser terminal, and electronic coupon, establishing a relationship of correspondence therebetween (see column 6, line 29 – column 7, line 27).

As per claims 4 and 14, Nielsen teaches:

An electronic coupon system according to claim 2 wherein said purchaser terminal, in accordance with an operation by a user wishing to become a member, sends membership application information including user information identifying said user to said marketing server (see column 5, lines 34 – column 6, line 29; column 4, lines 26-65; for the vendor and member being able to decrypt and encrypt data, both

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entities would have to share public and private keys. Therefore, it is inherent that users have to be members of a vendor to be able to decrypt said vendor's data).

said marketing server, when membership application information is sent from said purchaser terminal, records said member information identifying said applying user into a member information storage section, and sends a decryption key for decrypting discount information included in an electronic coupon to said purchaser terminal that sent said membership application (see column 5, line 34 – column 6, line 29; column 4, lines 26-65).

As per claims 5 and 15, Nielsen teaches:

An electronic coupon system according to claim 4, wherein said order information includes an electronic coupon to be used, and

said marketing server, when order information is sent from said purchaser terminal, checks validity of said electronic coupon included in said order information (see column 7, lines 9-35) but does not expressly teach and, in a case in which said electronic coupon is not valid, rejects said order information and stores use of an invalid electronic coupon as historical information of said user who sent said order information. However, it is inherent that if Nielsen stores in a database the name of a purchaser and the merchandise that was purchased (see column 1, lines 54-64), then Nielsen also stores in said database the coupon data, be valid or not.

As per claims 6 and 16, Nielsen teaches:

An electronic coupon system according to claim wherein said marketing server rejects order information from anyone but a user for whom member information has been registered in said member information storage section (see column 7, lines 1-27) .

As per claims 7 and 17, Nielsen teaches:

An electronic coupon system according to claim 6, wherein said user is either an individual user or a corporate user (see column 2, lines 17-26).

As per claims 9 and 19, Nielsen teaches:

An electronic coupon system according to claim 1, wherein said discount information is a discount rate or a discount price (see column 5, lines 55-65).

As per claims 10 and 20, Nielsen teaches:

An electronic coupon system according to claim 1, wherein said network is the Internet (see column 3, lines 5-10).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen (US 6,002,771) in view of Mankoff (US 6,385,591).

As per claims 8 and 18, Nielsen teaches:

An electronic coupon system according to claim 1, wherein said discount information included in said electronic coupon is encrypted (see figure 5) but fails to

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teach by means of an electronic watermark. Mankoff teaches the encryption of electronic coupon by means of an electronic watermark (see column 5, lines 30-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Nielsen would use digital watermark to encrypt coupon data, as taught by Mankoff. This feature would serve as fraud prevention, as the watermark would prevent alteration of coupon's data without the proper decryption key.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Boal teaches an electronic coupon distribution system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 571-272-6724. The Rightfax number of the Examiner is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
May 9, 2005


RETTA YEHEDEGA
PRIMARY EXAMINER